



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Pettigrew

Serial No.: 09/808,200

Filed: 03/13/2001

For: GOLF BALL WITH
TEXTUAL INSTRUCTIONS
POSITIONED THEREON

Docket: PET1P001A

Examiner: Hunter, A.

Date: November 06, 2003

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B Ross

Commissioner for Patents
Alexandria, VA 22313-1450

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ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on September 10, 2003.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. § 1.192(a))

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

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III	STATUS OF CLAIMS
IV	STATUS OF AMENDMENTS
V	SUMMARY OF INVENTION
VI	ISSUES
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IX	APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

The final page of this brief bears the practitioner's signature.

I REAL PARTY IN INTEREST (37 C.F.R. § 1.192(c)(1))

The real parties in interest in this appeal are Stephen H. Pettigrew and Victoria I. Pettigrew.

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no other such appeals or interferences.

III STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 21, 23, 24, 30 and 32-35.

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims withdrawn from consideration but not canceled: None
2. Claims pending: 21, 23, 24, 30 and 32-35
3. Claims allowed: None
4. Claims rejected: 21, 23, 24, 30 and 32-35

C. CLAIMS ON APPEAL

The claims on appeal are: 21, 23, 24, 30 and 32-35

IV STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

As to the status of any amendment filed subsequent to final rejection, applicant has made no such amendments under final.

V SUMMARY OF INVENTION (37 C.F.R. § 1.192(c)(5))

A method and apparatus are provided for improving the manner in which a golf ball is played by a user during golf. To accomplish this, instructional indicia is provided like that set forth in Figure 2A and the accompanying description. Such indicia includes a drive target marking situated on the body of the golf ball, so that the user may utilize the drive target marking to determine a point on the golf ball to be struck when driving. Still yet, the indicia further includes text which indicates that the drive target marking is the point on the golf ball to be struck when driving.

Further, as shown in Figures 1A-1B, an instructional golf ball is provided with a pair of spaced parallel bands flanking an equator of a body of the golf ball. A putt target marking is situated on the equator of the body between the bands, such that the putt target marking is adapted for indicating a point on the golf ball to be struck when putting. In use, the bands indicate any spin associated with the golf ball after putting. Still yet, text indicates that the putt target marking is the point on the golf ball to be struck when putting.

VI ISSUES (37 C.F.R. § 1.192(c)(6))

Issue # 1: The Examiner has rejected Claims 21, 23, 24, 30, 32-34 under 35 U.S.C. 103(a) as being unpatentable over Knight et al. (USPN 676506) in view of Karasavas (USPN 5133556) and Sellar (USPN 5662530) in further view of Johnson (USPN 5704846). The Examiner has further rejected Claims 35 under 35 U.S.C. 103(a) as being unpatentable over Knight et al. (USPN 676506) in view of Karasavas (USPN 5133556) and Sellar (USPN 5662530) in further view of Johnson (USPN 5704846) and Goranson et al. (USPN 3420529). Applicant respectfully disagrees with such rejections.

VII GROUPING OF CLAIMS (37 C.F.R. § 1.192(c)(7))

Issue # 1: Grouping of Claims – Group #1: Claims 21, 23, 25, 30, 32-34, 35

VIII ARGUMENTS (37 C.F.R. § 1.192(c)(8))

Issue #1:

The Examiner has rejected Claims 21, 23, 24, 30, 32-34 under 35 U.S.C. 103(a) as being unpatentable over Knight et al. (USPN 676506) in view of Karasavas (USPN 5133556) and Sellar (USPN 5662530) in further view of Johnson (USPN 5704846). The Examiner has further rejected Claims 35 under 35 U.S.C. 103(a) as being unpatentable over Knight et al. (USPN 676506) in view of Karasavas (USPN 5133556) and Sellar (USPN 5662530) in further view of Johnson (USPN 5704846) and Goranson et al. (USPN 3420529). Applicant respectfully disagrees with such rejections.

The Examiner makes an assertion that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate text on any type of device or object, as taught by Johnson, in order to indicate instructions, in particular, how to address a golf ball. Applicant respectfully disagrees with this blanket assertion.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991). Applicants respectfully assert that at least the first and third elements of the *prima facie* case of obviousness have not been met.

Specifically, the Examiner's proposed combination still fails to meet applicant's claims, and thus fails the third prong of the *prima facie* case of obviousness. The prior art references (when combined) do not teach or suggest all the claim limitations. Only applicant teaches and claims "text [that] indicates that the putt target marking is the point on the golf ball to be struck when putting" and "indicia [that] further includes text which indicates that the drive target marking is the point on the golf ball to be struck when

driving." In sharp contrast, Johnson merely teaches various phrases such as "RELAX, STANCE, ARM STRAIGHT, LOOSEN GRIP, EASY SWING." See except below:

"Desirably, a series swing tips 116 to the golfer using sleeve 12 are printed, embossed or otherwise provided on the outer face of wall member 24 directly below pocket 60 and the area 50.

Exemplary tips may for example be the terms "RELAX, STANCE, ARM STRAIGHT, LOOSEN GRIP, EASY SWING", which are in the order that the golfer should follow in preparing to swing club 22. It is also noteworthy that the words constituting swing tips for the golfer are at an angle such that the individual can readily read the text when he or she addresses the ball as depicted in FIG. 1." (col. 6, lines 45-55)

Thus, Johnson's indicia fails to meet applicant's functional limitations highlighted above. The third prong of the *prima facie* case of obviousness is thus not met.

With respect to the first prong of the *prima facie* case of obviousness; there is much evidence that counters the Examiner's erroneous suggestion that there is a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

For example, Knight, Karasavas, and Sellar all specifically teach improvements to the field of golf "balls." In sharp contrast, Johnson *teaches away* from improvements to golf "balls," by disclosing improvements to "inflatable tubular sleeve[s]" for use during golf. See *In re Nielson*, 816 F.2d 1567, 2USPQ2d 1525 (Fed. Cir. 1987). Johnson simply fails to teach any improvements to the "balls" themselves, and instead only addresses "inflatable tubular sleeve[s]."

It would thus be improper to simply glean indicia features from the art of "inflatable tubular sleeve[s]" of Johnson and combine the same with the *non-analogous* art of golf balls of Knight, Karasavas, and Sellar in an attempt to meet applicant's claims. See *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

Still yet, references are not properly combinable or modifiable if their intended function is destroyed. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Johnson clearly teaches indicia for helping a user to prepare for a swing. The Examiner admits this in the most recent action. In contrast, applicant's intended function is to indicate "the point on the golf ball to be struck when putting" and "the point on the golf ball to be struck when driving" (emphasis added). Thus, a modification of Johnson's indicia would be required to meet applicant's claims. Moreover, such a modification would destroy and/or frustrate the purpose/function of the Johnson invention since aiding the preparation of a swing by indicating "RELAX, STANCE, ARM STRAIGHT, LOOSEN GRIP, EASY SWING" is very different in function/purpose with respect to indicating "the point on the golf ball to be struck when putting" and "the point on the golf ball to be struck when driving" (emphasis added), as claimed by applicant. Thus, one of ordinary skill in the art would not have found a reason to make the Examiner's proposed modification/combination.

In the Examiner's latest action, it is argued that the prima-facie obviousness is met because Johnson teaches "text being used to indicate what the user should do." Applicant again contends that "text being used to indicate what the user should do" does not meet applicant's claimed "text [that] indicates that the putt target marking is the point on the golf ball to be struck when putting" and "text which indicates that the drive target marking is the point on the golf ball to be struck when driving."

The Examiner continues to argue that "[u]sing text to teach instructions has been around for centuries. It does not become patentable because one places it on a golf ball." In response, applicant notes the following from *In re Miller*, 418 F.2d 1392, 64 USPQ 46 (CCPA 1969):

"The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship..."

Again, it would hinder one considerably to have to continuously be distracted from a golf ball during a swing in order to read and benefit from textual indicia on a leg/arm harness. To solve such problem, applicant's claimed features allow for "using [text] indicia situated on the outer surface of the body [of a golf ball]," as specifically claimed, such that a user's attention may remain on a ball where it belongs.

IX APPENDIX OF CLAIMS (37 C.F.R. § 1.192(c)(9))

The text of the claims involved in the appeal are:

21. An instructional golf ball comprising a pair of spaced parallel bands flanking an equator of a body of the golf ball, and a putt target marking situated on the equator of the body between the bands, wherein the putt target marking is adapted for indicating a point on the golf ball to be struck when putting, and the bands indicate any spin associated with the golf ball after putting, wherein text indicates that the putt target marking is the point on the golf ball to be struck when putting.

23. The instructional golf ball as recited in claim 21, and further comprising a drive target marking situated on the body of the golf ball, wherein the drive target marking is adapted for indicating a point on the golf ball to be struck when driving.

24. The instructional golf ball as recited in claim 23, wherein text indicates that the drive target marking is the point on the golf ball to be struck when driving.

30. A method of improving the manner in which a golf ball is played by a user during golf, comprising: placing a golf ball on a ground surface, the golf ball including a spherical body having an outer surface with a plurality of dimples formed thereon; and

using indicia situated on the outer surface of the body;

wherein the indicia includes a pair of spaced parallel bands that flank an equator of the body of the golf ball, and a putt target marking situated on the equator of the body between the bands, and further comprising using the putt target marking when putting, and the using the bands to detect any spin associated with the golf ball after putting, wherein text indicates that the putt target marking is the point on the golf ball to be struck when putting.

32. The method as recited in claim 30, wherein a drive target marking is situated on the body of the golf ball, and further comprising using the drive target marking to determine a point on the golf ball to be struck when driving.

33. The method as recited in claim 32, wherein text indicates that the drive target marking is the point on the golf ball to be struck when driving.

34. A method of improving the manner in which a golf ball is played by a user during golf, comprising: placing a golf ball on a ground surface, the golf ball including a spherical body having an outer surface with a plurality of dimples formed thereon; and using indicia situated on the outer surface of the body; wherein the indicia includes a drive target marking situated on the body of the golf ball, and further comprising using the drive target marking to determine a point on the golf ball to be struck when driving, wherein the indicia further includes text which indicates that the drive target marking is the point on the golf ball to be struck when driving.

35. The method as recited in claim 34, wherein feet indicia indicative of feet of the user is situated on the outer surface of the body, the feet indicia illustrating a proper positioning of the feet of the user.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. PET1P001A).

Respectfully submitted,

By: _____

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